

REMARKS

Drawings

As requested by the Examiner, the Applicant is submitting proposed additional formal drawings based on the specification, but no new matter has been added (see original specification, page 9, line 7 -14, claims 13 and 14). In the proposed Figs. 6 and 6A, the bottom side of the insertable screen being pinched between the spare tire gate and the back gate is shown. These drawings are supported by the original specification are not new matter. Therefore, Applicant kindly asks the Examiner enter these drawings and to withdraw her objection.

Specification

In the specification, the paragraphs following the paragraph beginning at page 7, line 11 have been added to refer to the new Figs. 6 and 6A., and the paragraph beginning at page 9, line 7 has been amended to refer to Figs. 6 and 6A, but no new matter has been added (see original specification, page 9, line 7 -14, claims 13 and 14). In the proposed Figs. 6 and 6A, the bottom side of the insertable screen being pinched between the spare tire gate and the back gate is shown. These amendments are supported by the original specification are not new matter.

Claim Status

Claims 1-18 are pending in the Application. The Examiner has rejected claims 1-12, 15, and 16. The Examiner has objected to claims 13, 14, 17, and 18. Claims 1, 2, 15 and 17 have been amended and claim 10 has been canceled. Applicant believes that the amendment is fully supported by the specification and claims as filed (see e.g. Applicant's specification, pg. 2, lines 12 -20).

Claim Rejections - 35 U.S.C. § 103

The Examiner rejected Applicant's claims under 35 U.S.C. §103(a).

In re Application of: Evans, Edwin
Application No.: 10/035,969
Atty. Docket No.: PHDL0640-001

Art Group: 3612
Examiner: Engle, Patricia L.

Amendments to the Drawings:

The attached sheet of drawings includes Figs. 6 and 6A as supported by the specification and claims as originally filed.

Attachment: New Drawing Sheet

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

The Examiner rejected claims 1-3, 6, 7, 11, 12, 15, and 16 under 35 U.S.C. § 103(a) as obvious over U.S. Pat. No. 5,678,882 issued to Hammond ("Hammond '882"), in view of a JEEP® Wrangler®. The Examiner claimed that the teachings of Hammond '882 and a JEEP® Wrangler® would have motivated one skilled in the art to combine the two prior art devices to create Applicant's window system for convertible motor vehicles. The Examiner also rejected claims 4, 5, 8, 9, and 10 under 35 U.S.C. §103(a) as obvious over Hammond '882 in view of the Applicant's Admitted Prior Art ("AAPA"). The Applicant respectfully disagrees with Examiner's position.

1. The combination of Hammond '882 with a JEEP® Wrangler® does not teach Applicant's invention and would destroy the intended function of Hammond '882.

Claims 1-3, 6, 7, 11, 12, 15, and 16 of Applicant's invention were rejected over Hammond '882 in light of a JEEP® Wrangler®. The Examiner stated that it would have been obvious to one of ordinary skill in the art to use the window system of the Hammond '882 patent in a JEEP® Wrangler®. If a proposal for modifying the prior art in an effort to attain the claimed invention causes the art to become inoperable or destroys the intended function, then the requisite motivation to make the modification would not have existed. *See, In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 n.12 (Fed. Cir. 1983). Applicant kindly disagrees with the Examiner's rejections because Hammond '882 teaches away from Applicant's invention, and it is impermissible to combine Hammond '882 with the JEEP® Wrangler® because it would destroy the intended function of Hammond '882.

Specifically, Applicant's invention is a convertible soft covering system having a soft cover window frame, whereas the Hammond '882 window system is used with a conventional glass window that rolls up and down along a door window gasket groove but is

not removed (Hammond '882, Column 14, lines 7-8). The plastic windows are removable from the soft cover window frame of the convertible soft-covering system of the vehicle. The removal of the windows from the soft cover window frame allows air to flow into the passenger compartment while the soft-covering system is installed on the vehicle.

In contrast, the window system in Hammond '882 requires a conventional glass vehicle window system for proper installation. The removable window in Hammond '882 is installed on the passenger compartment of a vehicle by inserting its edges into a door window gasket groove (Hammond '882, Column 14, lines 3-11) when the glass window is in the rolled down position. The glass window is then raised until it comes in contact with the bottom of the removable window (Hammond '882, Column 14, lines 16-19) and holds the removable window in place. Therefore, because a JEEP® Wrangler® does not include a glass window that rolls up and down along a window gasket groove, the combination of a JEEP® Wrangler® with Hammond '882 would destroy the intended function of Hammond '882. Thus, Applicant kindly requests that the rejections be withdrawn as to claims 1-3, 6, 7, 11, 12, 15, and 16.

2. Neither Hammond '882 nor the "Applicant's Admissions" or their combination teach or enable Applicant's claims.

The Examiner rejected claims 4, 5, 8, 9, and 10 under 35 U.S.C. §103(a) as obvious. The Examiner claimed that it would have been obvious to combine the Hammond '882 patent with "Applicant's Admissions" to produce the objected claims. Applicant does not believe that Hammond '882, alone, or in combination with Applicant's disclosure teach or fairly suggest the creation of a window system for a vehicle with a convertible soft-covering system. In fact, Hammond '882 teaches away from Applicant's invention because Hammond '882 is used for camping (Hammond '882, Column 3, lines 28-32). Further, as stated above, Applicant believes that the intended function of Hammond '882 (i.e. a removable window that is partly secured with a glass vehicle window that rolls up and down a door window gasket) is destroyed when combined with the prior art. Therefore, Applicant kindly requests that the rejections be withdrawn as to claims 4, 5, 8, 9, and 10.

Double Patenting

The Examiner has indicated that claim 10 will be objected to if claim 9 is found allowable because claim 10 is a substantial duplicate of claim 9. Applicant kindly requests that claim 10 be cancelled from the application.

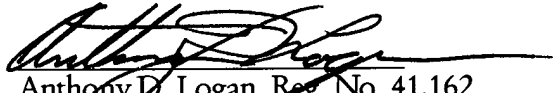
The Examiner has also indicated that claims 17 and 18 are objected to as being a substantial duplicate of claims 13 and 14. Applicant kindly disagrees with the Examiner's rejection because claims 13 and 14 are different in scope from claims 17 and 18. Claims 13 and 14 are limited by their dependence on claim 1. Claim 1 has been amended to include a *passenger compartment* into the claim. Therefore, Applicant kindly requests that the objections to claims 17 and 18 be withdrawn.

Conclusion

Applicant believes he has addressed and responded to every point raised in the Examiner's action. For the reasons stated above, Applicant respectfully requests reconsideration of its application.

Respectfully submitted,

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